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No. 92-33

Supreme Court, U.S.
FILED
JUL 30 1992
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1992

ROSE ART INDUSTRIES, INC.,

Petitioner,

vs.

KENNER PARKER TOYS INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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QUESTIONS PRESENTED

The Federal Circuit held that Petitioner's proposed trademark FUN DOUGH was confusingly similar to the famous PLAY-DOH mark of Respondent. The questions presented are:

1. Whether the Federal Circuit's application of undisputed rules of trademark law presents important questions of law that require determination by this Court; and

2. Whether this Court's supervisory authority is required to review the Federal Circuit's reversal of a clear error of the Trademark Trial and Appeal Board in failing to follow the established rules - not disputed by Petitioner - that famous marks receive a broad scope of protection, and that competing marks should not be dissected into their component parts in analyzing likelihood of confusion.

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The opinions below are set forth in the Appendices to Petitioner's Petition for Writ of Certiorari.

PARTIES

The caption of the case in this Court contains the names of all parties to the proceeding in the United States Court of Appeals for the Federal Circuit whose judgment is sought to be reviewed. Pursuant to Rule 29.1 of the Rules of the Supreme Court of the United States, Hasbro Corporation, Inc. is the parent corporation of Kenner Parker Toys, Inc.

STATUTES INVOLVED

Section 13(a) of the Lanham Act, 15 U.S.C. §1063(a), provides in pertinent part:

> Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered . . .

Section 1052 of the Lanham Act, 15 U.S.C. §1052, provides in pertinent part:

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . .
>
> (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of

> the applicant, to cause confusion, or to cause mistakes, or to deceive . . .

Section 21 of the Lanham Act, 15 U.S.C. §1071, provides in pertinent part:

> (a)(1) . . . [A] party to an opposition proceeding . . who is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section . . .
>
> (4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Commissioner, which shall be entered of record in

the Patent and Trademark Office and shall govern the further proceedings in the case . . .

No. 92-33

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1992

ROSE ART INDUSTRIES, INC.,

Petitioner,

v.

KENNER PARKER TOYS, INC.,

Respondent.

BRIEF IN OPPOSITION TO A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioner Rose Art Industries, Inc. requests this Court to issue a writ of certiorari to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit holding

that its adoption of the FUN DOUGH name was an inexcusable attempt to devise a trademark impermissibly similar to, and likely to cause confusion with, the famous PLAY-DOH trademark for use on identical products. As shown below, the Federal Circuit, taking into account the entire record, correctly applied longstanding fundamental principles of trademark law to reach a correct result. The decision does not raise any questions necessitating review by this Court and thus the Petition should be denied.

STATEMENT OF THE CASE

Introduction

Respondent opposed Petitioner's application in the United States Patent and Trademark Office to register FUN DOUGH as a trademark for toys on the ground that its confusing similarity to the famous PLAY-DOH mark, for the

identical products, was in violation of §1052(d) of the Lanham Act. The Trademark Trial and Appeal Board ruled that, despite the similarities between the marks, the fame of the PLAY-DOH mark would enable consumers to distinguish the FUN DOUGH mark. The United States Court of Appeals for the Federal Circuit reversed the Board's clear error of law, in evaluating the numerous factors governing determinations of trademark confusing similarity, by failing to apply the longstanding rule of trademark law that famous marks, such as PLAY-DOH, are entitled to an even broader scope of protection than lesser-known marks, and therefore held, based on the record in this case, that Petitioner's adoption of such a similar mark to PLAY-DOH was impermissible.

Statement of Facts

1. PLAY-DOH Is A Famous Mark

Respondent proved, Petitioner conceded, and the Trademark Trial and Appeal Board (the "Board") found that PLAY-DOH is a famous mark. For example, among its other findings regarding the fame of Respondent's PLAY-DOH mark, the Board found:

> The PLAY-DOH line of products comprises ten to fifteen percent of [Respondent's] total sales. In 1988 wholesale sales of this product exceeded $30 million, while over $2 million was spent in advertising and promotion. At one time the most advertised product in the toy industry (Mendelsohn dep., 21), the PLAY-DOH product is still well known in the toy field and is a market leader with sixty to seventy percent of the modeling compound market (Mendelsohn dep., 142). There is a high unaided brand awareness of this toy. According to a former officer of [Respondent], this "piece of gold" has lasted over thirty years as a successful toy, a very unusual occurrence in the toy business (Mendelsohn dep., 61-62).

> Repeat purchases are common partially because the product is used up.

Trademark Trial and Appeal Board opinion, dated April 29, 1991, attached to Petitioner's Petition for Writ of Certiorari as Appendix B ("Board Opinion") at B-3. Petitioner, in the person of its president, Lawrence Rosen, has conceded the fame of the PLAY-DOH mark, placing it in a category with the famous GI JOE and BARBIE marks. (Rosen Tr. 102-103 (A 2716-17); Rosen Dep. 110-11 (A2095-96).)[1]

2. The PLAY-DOH Products and Packaging Trade Dress

Toys bearing the PLAY-DOH mark include modeling compound, accessory products, such as plastic molds and extruder devices for shaping the

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[1] Factual citations refer to the Joint Appendix submitted to the Federal Circuit, and will be cited "Name of Document or witness (A__)."

modeling compound, and many combination sets, such as the PLAY-DOH FUN FACTORY and PLAY-DOH DISNEY DUCK TALES sets. (Kent Tr. 6, 10-17 (A882, 886-93); Opp. Exs. 14A, 14C, 14D, 15A-H, 16, 18K (A1077, 1079-81, 1082-1106, 1277-1284).)

The overall look of PLAY-DOH packaging has remained consistent throughout the years. The predominant background color is yellow, an atypical color for toy packaging. (Kent Tr. 8, 60-61 (A884, 936-37); Mendelsohn Tr. 45-46 (A274-75); Opp. Ex. 6, 12A-M, 14A, 14B, 18A-K (A471-72, 538-669, 1077-78, 1132-1306).) Since the early 1960's, a fanciful character -- named the PLAY-DOH BOY -- has also consistently been featured on all PLAY-DOH packaging. United States Court of Appeals for the Federal Circuit opinion, dated April 15, 1992, attached to Petitioner's Petition for Writ of Certiorari as Exhibit A

("Federal Circuit Opinion") at A-5. Since around 1975, the PLAY-DOH BOY head design has been part of the PLAY-DOH logo, which appears on the upper left-hand side of PLAY-DOH packages. (Opp. Exs. 12F, 14A-D, 15A-H, 18A-K (A586-95, 1077-81, 1082-1102, 1132-1306).)

3. Petitioner's FUN DOUGH Modeling Compound And Accessory Products

Around 1985, Petitioner decided to develop a non-clay modeling compound that would replicate Respondent's PLAY-DOH modeling compound. (Rosen Tr. 32-33 (A 2648-49).) Some of Petitioner's combination modeling compound and related accessory toy sets include the FUN DOUGH SUPER PLAY SHOP, the FUN DOUGH SUPER SPACE CENTER, the FUN DOUGH FUN SETS, the FUN DOUGH SNACK'N'GO FUN SHOP, and the FUN DOUGH CRAZY CHARACTER SUPER set. (App. Ex. 122, pp. 28-34 (A2884-90).)

FUN DOUGH modeling compound and accessory toy products are "practically identical" to PLAY-DOH products. (Federal Circuit Opinion at A-11.) Each is sold in packs of modeling compound and each is sold in sets with toy accessories and extruder items. (Id. at A-5.) Each is sold in the same channels of trade, i.e., toy stores, discount stores, supermarkets, and school supply distributors. (Id. at A-5.) "Both marks appear on inexpensive products purchased by diverse buyers without exercising much care." (Id. at A-12.)

Although Petitioner never engaged in any television or print advertising of its FUN DOUGH products, sales of those products nevertheless grew from approximately $50,000 in 1987 to over $500,000 in 1988. (Id. at A-5.)

4. Petitioner Intended To Trade On the Reputation of the Famous PLAY-DOH Mark

Lawrence Rosen, Petitioner's President, selected the FUN DOUGH mark at some point in late 1985. (Rosen Tr. 32-33 (A2648-49).) His choice of that mark, and the packaging for it, was not made in a vacuum. Mr. Rosen was very familiar with the strength and the registrations of the PLAY-DOH mark at the time the FUN DOUGH mark was adopted. (Rosen Tr. 88-90, 92 (A2702-04, 2706).) Mr. Rosen also was fully familiar with the PLAY-DOH product packaging and product line. (Rosen Tr. 88-90 (A2702-04); Rosen Dep. 114-15 (A2099-2100).)

While Petitioner is correct that other third-parties use "dough" in their brand names for modeling compounds, e.g., COLOR DOUGH, HAPPY DOUGH, SUPER DOUGH (Board Opinion at B-5), none of

these marks, taken in their entireties, have such a strong similarity to PLAY-DOH as Petitioner's FUN DOUGH mark.

The Federal Circuit found the following with respect to Petitioner's selection of its FUN DOUGH trade dress:

> The multitude of similarities in the trade dress of PLAY-DOH and FUNDOUGH products cries out for recognition. The color (dominated by yellow), size, and shape of the packaging for both products is the same. Comparable fictitious characters in a hat adorn the packaging of both products. Both products feature promotions -- discounts, rebates, and the like -- in a circle with serrated edges. The marks themselves appear in coinciding locations on both products' packages. The instructions and color charts on both packages are nearly identical. Both products display a rainbow motif. These trade dress features and more -- original to PLAY-DOH -- have appeared on products bearing the FUNDOUGH mark.

(Federal Circuit Opinion at A-12-13.)

In view of this overall similarity of the respective marks and trade dress, coupled with Petitioner's admitted lack of advertising, Respondent believed it

to be obvious that Petitioner selected its mark and trade dress as an effective substitute for independent advertising.

Procedural History of the Case

Petitioner filed an application in March 1986 to register the mark FUN DOUGH for toys, namely, modeling compound and related accessories for use with modeling compound sold as a unit. The mark was published for opposition in the Official Gazette on July 8, 1986. Respondent opposed the application in the Patent and Trademark Office under section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), in light of the confusing similarity between FUN DOUGH and PLAY-DOH, the latter having been used and registered for identical and

other related products for over 30 years.[2]

Both sides before the Board, the Federal Circuit, and this Court agree that in making a legal determination of likelihood of confusion a court must evaluate a series of factors known as the duPont factors.[3]

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[2] In such trademark opposition proceedings, there is no "trial" in the usual sense before the decision-making body, the Trademark Trial and Appeal Board. Rather, the determination is based solely upon briefs, documentary submissions, and selected excerpts from depositions. Trademark Rules of Practice, 37 C.F.R. 2.122-2.129.

[3] In determining the likelihood of confusion between two marks, the Federal Circuit analyzes a series of factors first set forth in In re E.I. duPont de Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973): (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services involved; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made; (5) the fame of the

(continued...)

In an opinion dated April 29, 1991, the Board erroneously concluded that, despite the similarities in connotation between the marks as a whole, there was no likelihood of confusion between PLAY-DOH and FUN DOUGH. The Board's analysis of the similarity of the marks was premised on its conclusion that, because of the "renown" of the PLAY-DOH mark, "few would pause to analyze any similarity in meaning of the prefixes 'PLAY' and 'FUN' in the marks," citing in support B.V.D. Licensing Corp. v.

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[3](...continued)
prior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interface between applicant and owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion; and (13) any other established fact probative of the effect of use. 476 F.2d at 1361.

Body Action Design, Inc., 846 F.2d 727 (Fed. Cir. 1988). Thus, despite its claims to the contrary, the Board effectively counted this key fifth duPont factor -- the fame of the mark -- against Respondent,[4] in disregard of extensive legal precedent holding that famous marks are entitled to a broad scope of protection.

The Board thus concluded that despite the similarity of the marks as a whole, because of the fame of the PLAY-DOH mark, purchasers would likely be able to distinguish FUN DOUGH from PLAY-

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[4] Although the Board claimed that this factor "operate[d] in [Respondent's] favor," it nonetheless adopted Petitioner's position that consumer familiarity with PLAY-DOH would emphasize the differences between the PLAY-DOH and FUN DOUGH marks. (Board Opinion at B-9.)

DOH. Consequently, the Board found no likelihood of confusion.[5]

Respondent appealed from this decision and, on April 15, 1992, the Federal Circuit reversed. The Federal Circuit first noted that it accepted the Board's factual findings unless clearly erroneous, citing Stock Pot Restaurant, Inc. v. Stockpot, Inc., 737 F.2d 1576 (Fed. Cir. 1984). (Federal Circuit Opinion at A-6.) The Federal Circuit's review was thus confined to the Board's legal error in using the fame of PLAY-DOH against Respondent as the key reason for holding that there was no likelihood of confusion, citing its own precedents, Sweats Fashions v. Pannill Knitting Co., 833 F.2d 1560 (Fed. Cir. 1987), Specialty Brands, Inc. v. Coffee Bean

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[5] The Petition's mischaracterization of and misstatements concerning the Board's opinion are discussed infra at pp. 39-41.

Distributors, Inc., 748 F.2d 669 (Fed. Cir. 1984), and Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565 (Fed. Cir. 1983). (Federal Circuit Opinion at A-6.)

The Federal Circuit noted that when a famous mark is involved, the fifth duPont factor, the "fame of the prior mark, plays a dominant role." (Federal Circuit Opinion at A-6.) "Famous or strong marks enjoy a wide latitude of legal protection," noted the Federal Circuit. (Federal Circuit Opinion at A-7.) None of these basic legal rules of trademark law are questioned in the Petition for Certiorari.

The Federal Circuit then held that the Board legally erred in treating the fame of PLAY-DOH as a liability to Respondent in its assessment of

likelihood of confusion.[6] In the central holding of its opinion, the Federal Circuit stated:

> The Board erred in discounting the import of [Respondent's] famous prior mark. The Board acknowledged "the renown of [Respondent's] mark with respect to modeling compound." Indeed, [Petitioner] conceded this fame. Yet the Board treated that fame as a liability in assessing likelihood of confusion. Reasoning that consumers might more easily recognize variances from a famous mark, the Board concluded that the fame of [Respondent's] mark permitted greater, rather than less, legal tolerance for similar marks.

(Federal Circuit Opinion at A-8.) After rejecting the Board's erroneous treatment of the fame of the PLAY-DOH mark as a liability, rather than as an asset, the Federal Circuit correctly

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[6] It should be noted that the Federal Circuit did not overrule the Board on the factual issue of the fame of the PLAY-DOH mark -- in fact, it upheld the Board's factual finding that PLAY-DOH was famous. It only reversed the Board concerning the weight to be given this factor in its likelihood of confusion calculus -- a question of law.

applied "the standard consistently applied by this court -- namely, more protection against confusion for famous marks." (Federal Circuit Opinion at A-9.)[7] The Federal Circuit also recognized that its decision reinforced the purposes and benefits of the Lanham Act by applying a standard that creates an incentive for owners of marks to invest in their marks and increase the fame of their marks. (Federal Circuit Opinion at A-9-10.)

Contrary to Petitioner's assertion, the Federal Circuit did not reverse the Board's finding that the term "dough," a

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[7] The Federal Circuit also noted the Board had misread its prior decision in B.V.D. Licensing Corp. v. Body Action Design, Inc., supra, stating that, "[b]oth before and after B.V.D., this court has consistently afforded strong marks a wider latitude of legal protection than weak marks." (Federal Circuit Opinion at A-10.) The Federal Circuit also limited B.V.D., the decision relied on by the Board, to its facts. (Federal Circuit Opinion at A-10.)

component of Petitioner's mark, is generic for water-based modeling compound. The Federal Circuit merely stated that it "decline[d] to opine" on this issue. (Federal Circuit Opinion at A-11 n. 2.) As a result, the Federal Circuit only held that, even assuming the Board's finding to be correct, giving proper weight to the fame of PLAY-DOH, the marks as a whole were still inexcusably close and likely to cause confusion.[8]

Thus, the Federal Circuit considered the similarity of the marks as a whole and, in the context of the

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[8] It should be noted that the Federal Circuit also stated that "it is unclear that this issue [of the generic nature of the term "dough" for water-based modeling compound] properly arose before the Board." (Federal Circuit Opinion at A-11 n. 2.) This statement indicates that the Federal Circuit believed the issue upon which Petitioner bases its Petition for Certiorari was not properly before the Board in the first instance.

widespread recognition of PLAY-DOH, found that PLAY-DOH's fame would "magnif[y] the significance of these similarities" between the two marks. (Federal Circuit Opinion at A-11.) The court also considered all of the other duPont factors and held that "application of the various duPont factors to this case suggests that the Board erred as a matter of law in concluding that FUNDOUGH is not confusingly similar to PLAY-DOH." (Federal Circuit Opinion at A-12.) The Federal Circuit consequently reversed the Board's erroneous conclusion of law.

REASONS FOR DENYING THE PETITION

Summary of the Argument

This is a private commercial dispute between two toy companies involving the issue under federal law of whether two trademarks are confusingly

similar when used on identical goods. As demonstrated below, there is nothing in the decision below that merits the attention of the Supreme Court.

Petitioner presents no conflict among the Circuits or between the Federal Circuit s decision and a decision of a state court of last resort; nor is any state court decision involved.

Further, the criteria employed by the Federal Circuit were standard for the assessment of likelihood of confusion between two trademarks. In sum, the Federal Circuit correctly decided this case by applying the well-established principles of trademark law that famous marks must be afforded a broad scope of protection and that, in analyzing likelihood of confusion, marks must not be dissected, but must be examined in their entireties.

Petitioner does not dispute these rules, as indeed it cannot. Instead, Petitioner presents phantom issues concerning trademark genericness, having nothing to do with the case, along with unfounded allegations about the nature and content of the record and decisions below. Petitioner does this in an effort to create a basis for a Supreme Court review of a decision which was correct and which meets none of the accepted standards for the exercise of this Court's supervisory authority.

I. THE FEDERAL CIRCUIT CORRECTLY HELD THAT THERE WAS A LIKELIHOOD OF CONFUSION BETWEEN PLAY-DOH AND FUN DOUGH

A. The Federal Circuit Correctly Considered The Marks As A Whole, In Contrast to Petitioner's Erroneous Dissection Approach

The issue in a trademark case, based on section 2(d) of the Lanham Act, is whether, viewing the marks in their entireties, there will be a likelihood of confusion. See, e.g., In re E.I. duPont de Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973); Glenwood Laboratories, Inc. v. American Home Prod. Corp., 455 F.2d 1384, 1385 (C.C.P.A. 1972) ("The question of likelihood of confusion in this case depends upon a consideration of the marks reviewed in their entireties").

In finding that Petitioner had knowingly adopted a mark too similar to the famous PLAY-DOH brand name, the Federal Circuit correctly followed a long line of cases admonishing courts not to dissect trademarks into their component parts when analyzing confusing similarity between two marks. See In re National Data Corp., 753 F.2d 1056, 1058 (Fed. Cir. 1985); Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion"); Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 1402 (C.C.P.A. 1974); see also 2 McCarthy, Trademarks and Unfair Competition (2d ed. 1984), §23:15(A) at 80 ("A mark should not be split up into its

component parts and each part then compared with parts of the conflicting mark to determine the likelihood of confusion").

In disregard of this longstanding, fundamental rule of trademark law, Petitioner is improperly urging this Court to engage in improper dissection and to then focus on the alleged genericness of one component of its mark -- the term "dough" -- as "central" or "key" to the likelihood of confusion analysis.

The Federal Circuit correctly recognized that the precept of looking at marks in their entireties applies even if there are common portions of the respective marks which are generic or highly descriptive. See In re National Data Corp., supra, 753 F.2d at 1058-59; see also Banff, Ltd. v. Federated Dept. Stores, Inc., 841 F.2d 486 (2d Cir.

1988) (where "wear" generic for women's clothes, B WEAR confusingly similar to BEE WEAR); Coca-Cola Co. v. Old Dominion Beverage Corp., 271 F. 600 (4th Cir.), cert. denied, 256 U.S. 703 (1921) (although "cola" is generic, TAKA-COLA confusingly similar to COCA-COLA).

In Specialty Brands Co. v. Coffee Bean Distributors, Inc., supra, the Federal Circuit held that even if part of a mark is lacking in trademark significance it cannot be disregarded in the likelihood of confusion analysis:

> Of paramount interest is not the descriptive nature of SPICE, but the overall commercial impression derived by viewing the marks in their entireties . . . Arguments to the effect that one portion of a mark possesses no trademark significance leading to a direct comparison between only what remains is an erroneous approach.

748 F.2d at 673, quoting Spice Islands, Inc. v. Frank Tea and Spice Co., 505

F.2d 1293, 1295 (C.C.P.A. 1974)[9]; see also Magnovox Co. v. Multivox Corp., 341 F.2d 139, 141 (C.C.P.A. 1965) (in finding MULTIVOX for electric organs confusingly similar to MAGNAVOX for radios, televisions, phonographs, etc., the court noted: "[I]t is a question of the perception of the marks as a whole. It is for this reason that we reject the approach of the [Applicant], which dissects the mark into the parts 'MULTI' AND 'VOX' and then argues the latter part to be of 'no trademark significance' while the 'prefix' part is significantly different").

In its most recent ruling on this point the Federal Circuit has reiterated that the genericness of common portions

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[9] In comparing the marks, "the appellate court is in as good a position as the trial judge to decide the issue." See e.g., Miss Universe, Inc. v. Patricelli, 408 F.2d 506, 509 (2d Cir. 1969).

of two marks is not dispositive on the issue of likelihood of confusion and that the correct analytical approach must be to examine the marks in their entireties. Opryland USA, Inc. v. The Great American Music Show, Inc., -- F.2d --, 1992 U.S. App. Lexis 15889 (Fed. Cir. July 14, 1992).

Thus, Petitioner's argument that if two trademarks contain a common element, "the source identifying capability of the common portion is to be considered as an important (if not controlling) factor in determining likelihood of confusion"[10] is contrary to established law, and was quite properly not followed below.[11] Regardless of

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[10] This fallacious argument, made at page 33 of Petitioner's Certiorari Brief, was not presented below to the Board or the Federal Circuit.

[11] Even in the cases cited by Petitioner, the Court looked at the marks as a whole. See, e.g., Keebler

(continued...)

whether two marks contain a common element, the marks must be examined as a whole in making a determination that the two marks are confusingly similar. The Federal Circuit aptly applied this approach. Opryland USA, Inc. v. The Great American Music Show, Inc., supra; See In re National Data Corp., supra, 753 F.2d at 1060; Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., supra, 748 F.2d at 672.

B. The Federal Circuit Correctly Gave Greater Weight to the Fame of Respondent's Mark

The Board treated the fame of the PLAY-DOH mark as a liability, concluding

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[11](...continued)
Co. v. Murray Bakery Products, 866 F.2d 1386 (Fed. Cir. 1989); EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc., 706 F.2d 1213 (Fed. Cir. 1983). If anything, the common, descriptive component of these marks was less important, rather than "controlling," as Petitioner claims.

that because of its fame, consumers would be able to distinguish PLAY-DOH from other, confusingly similar marks. This approach, antithetical to long-standing rules of trademark law and the purposes of the Lanham Act, was properly rejected by the Federal Circuit, which instead reemphasized and reasserted the principle, accepted throughout the circuits,[12] that famous marks are entitled to a broad scope of protection.

Although Petitioner avoids the issue in its Brief, this in fact was the "central" issue decided by the Federal Circuit, i.e., famous marks cannot be

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[12] See, e.g., Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc., 889 F.2d 1070, 1073 (Fed. Cir. 1989); Volkswagenwerk Aktiengesellschaft v. Wheeler, 814 F.2d 812, 819 (1st Cir. 1987); Mobil Oil Corp. v. Pegasus Petroleum Corp., 818 F.2d 254, 258 (2d Cir. 1987); Wall v. Rolls-Royce of America, 4 F.2d 333, 334 (3d Cir. 1925); James Burrough Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 277 (7th Cir. 1976); SquirtCo v. Seven-Up Co., 628 F.2d 1086, 1091 (8th Cir. 1980).

penalized because of their renown. To do so would be to create a disincentive for trademark owners to advertise and increase public awareness of their marks. This, in turn, would decrease the information available to the consumer and heighten the possibility of consumer confusion -- exactly the opposite of what the Lanham Act was designed to do. 1 McCarthy, Trademarks and Unfair Competition, supra, § 5:4 at 141 (the Lanham Act seeks to increase the ability of consumers "to distinguish among goods of competing manufacturers"). Thus, the Federal Circuit's decision squarely upholds the purpose of the Lanham Act.

Similarly, there is no social benefit to allowing copycats, such as Petitioner, to come close to strong marks, thus possibly causing confusion:

> Indeed, it is generally true that, as soon as we see that a second

> comer in the market has, for no reason that he can assign, plagiarized the "make up" of an earlier comer, we need no more; for he at any rate thinks that any differentia he adds will not, or at least may not, prevent the diversion and we are content to accept his forecast that he is "likely" to succeed. Then we feel bound to compel him to exercise his ingenuity in quarters further afield.

Spring Mills, Inc. v. Ultracashmere House, Inc., 689 F.2d 1127, 1135 (2nd Cir. 1982), quoting American Chicle Company v. Topps Chewing Gum, Inc., 208 F.2d 560, 562-63 (2nd Cir. 1953).

Having corrected the Board's clear error in holding that the fame of PLAY-DOH undercut likelihood of confusion, the Federal Circuit then accorded to this factor its accepted significant weight in giving broad protection to the PLAY-DOH mark and reversing the Board's ruling that there was no likelihood of confusion.

C. The Federal Circuit's Decision Does Not Have An Anti-Competitive Effect

Nor does the Federal Circuit's opinion have any anti-competitive effect, as suggested by Petitioner. The decision below does not hold that all uses of "dough" in names of modeling compound or related products are prohibited; it simply holds that Petitioner's FUN DOUGH mark, and that mark alone, is too close to PLAY-DOH and therefore cannot be registered. Consequently, this decision will not remove the term "dough" from the marketplace.

Further, Petitioner mischaracterizes Respondent as attempting to monopolize the term "dough." The existence of third-party modeling compounds with the term "dough" in their brand names -- e.g., COLOR-DOUGH, SUPER DOUGH, HAPPY DOUGH -- demonstrate that

Respondent is not trying to monopolize "dough." Respondent in this case is properly exercising its statutory right to protect its mark against the registration of a trademark, which, when looked at as a whole, is likely to cause confusion with PLAY-DOH.

II. THERE IS NO REASON FOR THIS COURT TO SIT AS A SECOND APPELLATE COURT -- THIS IS NOT A CASE FOR SUPREME COURT REVIEW

A. By Misstating and Mischaracterizing Both the Board and Federal Circuit Decisions, Petitioner Has Attempted To Create A Non-Existent Issue Of Procedural Disregard Of Allegedly Significant Fact-Finding

Petitioner has mischaracterized the findings of both the Board and the Federal Circuit in an attempt to create

a false issue of procedural disregard by the Federal Circuit of allegedly significant fact-finding by the Board. An objective examination of these opinions, however, reveals that there was no such violation of the Federal Rules by the Federal Circuit.

(1) Petitioner's Misstatements About the Board's Decision

Petitioner repeatedly misstates and mischaracterizes the substance of the Board's decision. Petitioner states, for example, that the Board's conclusion of no likelihood of confusion "was based on the central finding of fact that 'DOUGH' and its phonetic equivalent 'DOH' are generic for this product." (Petitioner's Certiorari Brief at 14.) This statement is wrong in three respects. First, as noted above, the finding of the generic nature of "dough" with respect to water-based

modeling compound was not "central" to the Board's decision. That finding was only one of several factors evaluated by the Board in its likelihood of confusion calculus.[13]

Second, whether or not "dough" is generic for water-based modeling compound, "dough" is not a generic term for the many other toys identified by the PLAY-DOH and FUN DOUGH marks which are also involved in this case. Thus the genericness issue could not have had any bearing at all on the likelihood of

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[13] Other important findings of fact made by the Board included that (1) PLAY-DOH was a famous mark; (2) the components "PLAY" and "FUN," examined separately, while not similar in sound or appearance, shared a similar connotation; (3) the nature of the channels of trade of the two products were similar; (4) PLAY-DOH was the earlier use; (5) the goods involved were identical; and (6) there was no evidence of instances of actual confusion. All of these findings of fact were presumably weighed by the Board in arriving at its legal conclusion of no likelihood of confusion.

confusion between PLAY-DOH and FUN DOUGH as applied to these many other toys which are the subject of Petitioner's application to register the mark FUN DOUGH. Petitioner fails to inform this Court that the Board's finding of genericness of "dough" could not have applied to these other toys.

Third, Petitioner mischaracterizes the Board's finding of fact that PLAY-DOH is a famous mark and how the Board utilized that finding in its likelihood of confusion calculus. (Petitioner's Certiorari Brief at 17.) The Board only paid lip service to weighing the fame of PLAY-DOH in Respondent's favor. The Board's opinion in fact holds it is because of the fame of PLAY-DOH that confusion is not likely. Petitioner should have informed this Court of that fact.

(2) Petitioner's Misstatements About the Federal Circuit Decision

Petitioner states:

> On appeal, the CAFC refused to consider this central factual finding of the Board. It simply refused to deal with the very factual finding which it and its predecessor firmly established as an important if not controlling aspect of this type of inquiry.

(Petitioner's Certiorari Brief at 20.) This statement is misleading in several ways. First, as noted above, the Federal Circuit did not disregard the Board's finding of "genericness"; rather, it "decline[d] to opine" on the issue. (Federal Circuit Opinion at A-11 n. 2.) Thus, instead of reversing this finding as "clearly erroneous" (which the Federal Circuit could have done, since the issue of the generic nature of "dough" was not even properly before the Board, see Federal Circuit Opinion at A-11 n. 2 and p. 23, supra), the Federal

Circuit accepted the finding for what it was -- only one of the several factors in the likelihood of confusion calculus. This approach is consistent with long-established, standard appellate practice: Courts of Appeal regularly review only selected aspects of the decision below necessary to their opinion.

There is thus no basis for Petitioner's statements that F.R.C.P. 52(a) was disregarded here. The Federal Circuit accepted the factual findings of the Board, but reversed the Board on its ultimate conclusion that no likelihood of confusion existed -- a question of law to which the "clearly erroneous" standard of F.R.C.P. 52(a) does not apply. See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., supra, 748 F.2d at 671. Here, the Federal Circuit accepted the Board's

findings of fact, but arrived at a different legal conclusion based upon those facts. See Bose Corp. v. Consumers Union of U.S., Inc., 466 U.S. 485, 501 (1984) (F.R.C.P. 52(a) "does not inhibit an appellate court's power to correct errors of law"). Because the Federal Circuit here did not violate any procedural standards, the Court's "supervisory authority" need not be invoked, and the certiorari petition should not be granted.[14]

Second, as noted above, Petitioner, in any event, has misstated the governing legal principles relating to the effect of genericness in the

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[14] Furthermore, this Court has noted that it only will grant a petition for certiorari based upon a failure to comply with F.R.C.P. 52(a) if that Rule was ignored by the Court of Appeals, and not simply because that Rule was erroneously applied. See Inwood Laboratories v. Ives Laboratories, 456 U.S. 844, 859 (1982) (White, J., concurring).

likelihood of confusion analysis. When a "generic" term is only a portion of the competing marks, the "genericness" of that common element of the marks is not an "important if not controlling aspect" of the likelihood of confusion analysis. (Petitioner's Certiorari Brief at 33.) Although this fact is relevant, the marks must still be analyzed as a whole and if the competing marks as a whole are found to be confusingly similar, then, even if a "generic" term is encompassed within the marks, registration of the later mark will be prohibited. See In re National Data Corp., supra (CASH MANAGEMENT EXCHANGE and CASH MANAGEMENT ACCOUNT held confusingly similar, notwithstanding genericness of "cash management" portion).

B. Rule 10.1 Is Not Satisfied Here, And There Are No Other Reasons To Grant The Petition

1. Rule 10.1 is not satisfied

Whether to grant certiorari is discretionary with the Court. See Stern, Gressman & Shapiro, Supreme Court Practice (6th edition 1986), § 4.2 at 195. The Court has, nonetheless, established guidelines indicating those cases in which certiorari is likely to be granted. See Rule 10.1 of the Rules of the Supreme Court of the United States.[15] The instant Petition

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[15] Rule 10.1 itself notes that it is "neither controlling nor fully measuring [of] the Court's discretion," but does state that its provisions "indicate the character of reasons that will be considered" in the Court's exercise of its discretion in determining whether to grant a Petition for Certiorari. Moreover, this Rule sets forth the standards "traditionally employed" by this Court in deciding whether to grant petitions for

(continued...)

satisfies none of the categories in Rule 10.1.[16]

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[15](...continued)
certiorari. See Haitian Refugee Center, Inc. v. Baker, 117 L.Ed.2d 477, 478 (1992) (Thomas, J., respecting the denial of certiorari); see also Watt v. Alaska, 451 U.S. 259, 275 n. 5 (1981) (Stevens, J., concurring) ("Nonetheless, it is surely significant that none of the factors identified in the Rule can fairly be said to be present in this case").

[16] First, there is no conflict between the Federal Circuit and other Courts of Appeal on the issues presented here, and Petitioner claims none.

Second, the Federal Circuit's decision does not conflict with a state court of last resort's decision on a Lanham Act question, and Petitioner does not claim otherwise.

Third, the Federal Circuit did not "so far depart[ ] from the accepted and usual course of judicial proceedings . . . as to call for an exercise of this Court's power of supervision." Rule 10.1(a). This prong of Rule 10.1(a) addresses the Court's "supervisory authority" over the federal court system. See Florida v. Rodriguez, 469 U.S. 1, 7 (1984) (Stevens, J., dissenting); see also Stern, Gressman, & Shapiro, Supreme Court Practice, supra, § 4.15 at 220. Since there was no violation of F.R.C.P. 52(a), Petitioner's attempt to invoke this Court's "supervisory authority" over procedural mistakes of the federal

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Nevertheless, Petitioner attempts to satisfy Rule 10.1(c) by conjuring up purported "important" issues of federal law requiring resolution by the Supreme Court, when these in fact have been resolved for decades. As shown below, the second, third, and fourth "questions presented" by Petitioner are disingenuous inducements to this Court to make advisory and/or unnecessary rulings.

The second question presented by Petitioner, i.e., "whether the source identifying capability of a common portion of trademarks is an important factor in determining likelihood of confusion," is a question which merits

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[16](...continued)
courts as a basis for certiorari jurisdiction fails.

Fourth, Petitioner did not and, indeed, cannot claim that Rule 10.1(b) has been satisfied since this is a petition for a writ of certiorari to the United States Court of Appeals for the Federal Circuit, not a state court.

no attention. As set out in greater detail above, in accordance with the long-established test for assessing whether or not two trademarks are too close, the marks must be compared in their entireties. See, e.g., Magnavox Corp. v. Multivox Corp., supra. Such comparisons must be made in all cases even if the common components of the competing marks are generic terms. Opryland USA, Inc. v. The Great American Music Show, supra; In re National Data Corp., supra; Banff, Ltd. v. Federated Dept. Stores, Inc., supra; Coca-Cola Co. v. Old Dominion Beverage Co., supra. Neither similarities between, nor the source-identifying capabilities of, the common or non-common portions of the competing marks is conclusive. Regardless of the "source-identifying capability" of a portion of the mark, the marks in their entireties control

the determination of likelihood of confusion. See In re National Data Corp., supra; Spice Islands, Inc. v. Frank Tea & Spice Co., 505 F.2d 1293 (C.C.P.A. 1974).

The third question presented by Petitioner, i.e., "whether the trademark law protects the right of competitors to freely use generic terms to name their goods," was not an issue before the Board or Federal Circuit, and is similarly not a question which merits further attention. Competitors are free to use generic terms to describe their products. See 1 McCarthy, Trademarks and Unfair Competition, supra, § 12:2 at 527. However, that is not what Petitioner has done. Here, Petitioner is not being stopped from using "dough" to describe the product it is selling, but is only being told that it has no excuse for integrating that term into a

brand name which, as a whole, creates a likelihood of confusion with a prior user's famous mark. This is fundamental trademark law. In re National Data Corp., supra; Banff, Ltd. v. Federated Dept. Stores, Inc., supra; Coca-Cola Co. v. Old Dominion Beverage Co., supra.

The final question presented by Petitioner is "whether secondary meaning can attach to a generic term which is part of a famous mark." While it is true that secondary meaning cannot attach to a generic term in isolation, see 1 McCarthy, Trademarks and Unfair Competition, supra, § 12:14 at 560, it is well-known that secondary meaning can attach to a mark which contains a generic term[17] as a component thereof, such as the famous mark PLAY-DOH in this

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[17] It should be noted that Respondent does not, and has not, conceded that "dough" is generic for water-based modeling compound.

case or other famous marks like COCA-COLA. See also Schmidt v. Quigg, 609 F. Supp. 227 (E.D. Mich. 1985) (HONEY BAKED HAM not generic for hams that are honey glazed).

Petitioner's foregoing questions are all related to the issue of the "genericness" of "dough" for water-based modeling compound, which was not a central issue in the Federal Circuit decision. The "generic" nature of "dough" was only one factor in the Board's likelihood of confusion analysis reviewed by the Federal Circuit. Before the Board, this issue was not even briefed or otherwise addressed by the parties until oral argument. Nor was it decided by the Federal Circuit. See p.23, supra. Because the issue of whether "dough" is generic was not determined at the appellate level, this claim need not be considered by this

Court. See EEOC v. FLRA, 476 U.S. 19, 24 (1986) ("Our normal practice, from which we see no reason to depart on this occasion, is to refrain from addressing issues not passed in the Court of Appeals"); Delta Air Lines, Inc. v. August, 450 U.S. 346, 362 (1985) (where question was not raised in the Court of Appeals, it was "not properly" before the Supreme Court).

2. Petitioner here is simply seeking another hearing on its erroneous legal arguments

Petitioner's only objective is to obtain another appellate review of the decision below justly rejecting its attempt to ride on Respondent's coattails by selecting the confusingly similar mark FUN DOUGH out of all the multitudinous marks it could have chosen. In the absence of the most

extraordinary circumstances of broad significance to the nation, the Supreme Court does "not grant a certiorari to review evidence and discuss specific facts." Texas v. Mead, 465 U.S. 1041 (1984) (Stevens, J., respecting the denial of certiorari), quoting United States v. Johnston, 268 U.S. 220, 227 (1925); see also Watt v. Alaska, supra, 451 U.S. at 275 (Stevens, J., concurring) ("this Court does not sit primarily to correct what we perceive to be mistakes committed by other tribunals").

As former Chief Justice Vinson stated:

> The Supreme Court is not, and never has been, primarily concerned with the correction of errors in lower court decisions. In almost all cases within the Court's appellate jurisdiction, the petitioner has already received one appellate review of his case . . . . The function of the Supreme Court is, therefore, to resolve conflicts of opinion on federal questions that have arisen among lower courts, to

> pass upon questions of wide import under the Constitution, laws, and treaties of the United States, and to exercise supervisory power over lower federal courts . . . . To remain effective, the Supreme Court must continue to decide only those cases which present questions whose resolution will have immediate importance far beyond the particular facts and parties involved.

Address of Chief Justice Vinson before the American Bar Association, Sept. 7, 1949, 69 S. Ct. v, vi, cited in Boag v. MacDougall, 454 U.S. 364, 368 (1982) (Rehnquist, J., dissenting); see also Magnum Co. v. Coty, 262 U.S. 159, 163 (1923) (certiorari jurisdiction "was not conferred upon this Court merely to give the defeated party in the circuit court of appeals another hearing").

Accordingly, for all the foregoing reasons, this case does not present an important federal question that must be resolved by this Court, see, e.g., Chevron U.S.A. v. Sheffield, 471 U.S. 1140 (1985) (Stevens, J., in favor of

denial of certiorari), and has "no importance beyond the facts and parties involved,"[18] Boag v. MacDougall, supra, 454 U.S. at 368 (Rehnquist, J., dissenting). Therefore, certiorari should be denied.

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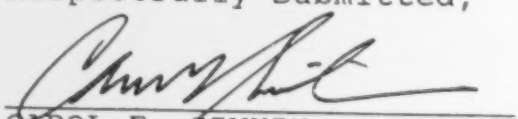
[18] The Federal Circuit's opinion is instructive in reminding trademark practitioners that famous marks are entitled to a broad scope of protection. However, this principle was not raised by Petitioner in its Petition for Certiorari. The "genericness" questions raised by Petitioner are, as noted above, not relevant to the Federal Circuit's ultimate legal conclusion that no likelihood of confusion exists between PLAY-DOH and FUN DOUGH. This legal conclusion is important only to the parties involved.

CONCLUSION

For the foregoing reasons, the Petition for Certiorari should be denied.

Dated: New York, New York
July 30, 1992

Respectfully submitted,



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